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TRANSMITTAL FORM

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Application Number	09/695,921
Filing Date	October 26, 2000
Inventor(s)	Mohamed Anisur RAHMAN et al.
Group Art Unit	2665
Examiner Name	Alpus Hsu
Attorney Docket Number	29250-000442/US

ENCLOSURES (check all that apply)

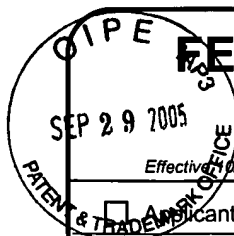
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Letter to the Official Draftsperson and _____ Sheets of Formal Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> LETTER SUBMITTING APPEAL BRIEF AND APPEAL BRIEF (w/clean version of pending claims) <input checked="" type="checkbox"/> Appeal Communication to Group (Notice of Appeal, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):			
<table><tr><td>Remarks</td><td rowspan="2">Mail Stop <u>Appeal Brief-Patents</u></td></tr><tr><td></td></tr></table>			Remarks	Mail Stop <u>Appeal Brief-Patents</u>	
Remarks	Mail Stop <u>Appeal Brief-Patents</u>				

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name	Gary D. Yacura	Reg. No.	35,416
Signature					
Date	September 29, 2005				

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FEE TRANSMITTAL for FY 2005

Effective 01/01/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500

Complete If Known

Application Number	09/695,921
Filing Date	October 26, 2000
First Named Inventor	Mohamed Anisur RAHMAN et al.
Examiner Name	Alpus Hsu
Art Unit	2665
Attorney Docket No.	29250-000442/US

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
☐ Deposit Account:

Deposit Account Number 08-0750

Deposit Account Name Harness, Dickey & Pierce, PLC

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments
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FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1011	300	2011	150	Utility filing fee	
1012	200	2012	100	Design filing fee	
1013	200	2013	100	Plant filing fee	
1014	300	2014	150	Reissue filing fee	
1005	200	2005	100	Provisional filing fee	

SUBTOTAL (1)

(\$) 0

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
20 **	0	X	0
Independent Claims	Extra Claims	Fee from below	Fee Paid
3 **	0	X	0
Multiple Dependent	Extra Claims	Fee from below	Fee Paid
			0

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	50	2202	25	Claims in excess of 20
1201	200	2201	100	Independent claims in excess of 3
1203	360	2203	180	Multiple dependent claim, if not paid
1204	200	2204	100	** Reissue independent claims over original patent
1205	50	2205	25	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$) 0

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1020	2253	510	Extension for reply within third month	
1254	1,590	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	0
1402	500	2402	250	Filing a brief in support of an appeal	500
1403	1000	2403	500	Request for oral hearing	
1452	500	2452	250	Petition to revive - unavoidable	
1453	1500	2453	750	Petition to revive - unintentional	
1501	1400	2501	700	Utility issue fee (or reissue)	
1502	800	2502	400	Design issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid SUBTOTAL (3) (\$) 500

4. SEARCH/EXAMINATION FEES

1111	500	2111	250	Utility Search Fee	
1112	100	2112	50	Design Search Fee	
1113	300	2113	150	Plant Search Fee	
1114	500	2114	250	Reissue Search Fee	
1311	200	2311	100	Utility Examination Fee	
1312	130	2312	65	Design Examination Fee	
1313	160	2313	80	Plant Examination Fee	
1314	600	2314	300	Reissue Examination Fee	

SUBTOTAL (4) (\$) 0

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Gary D. Yacura	Registration No. (Attorney/Agent)	35,416	Telephone	703-668-8000
Signature				Date	September 29, 2005

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PATENT

Atty. Docket No.: 29250-000442/US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/695,921
Filing Date: October 26, 2000
Applicant: Mohamed Anisur RAHMAN et al.
Group Art Unit: 2665
Examiner: Alpus Hsu
Title: SERVICE CREATION AND NEGOTIATION IN A
WIRELESS NETWORK
Conf No: 4316

APPEAL BRIEF

U.S. Patent and Trademark Office
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Mail Stop Appeal Brief-Patents

September 29, 2005

Dear Sir:

Appellants submit herewith their Brief on Appeal as required by 37 C.F.R. 41.37.

09/30/2005 HALI11 00000136 09695921

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BRIEF ON BEHALF OF APPELLANTS

Appellants appeal the Examiner's final rejection mailed July 6, 2005 for pending claims 1-30 of the present application which appear in the attached claims Appendix, and hereby provide the following remarks.

(1) **REAL PARTY IN INTEREST:**

The real party in interest is Lucent Technologies, Inc, as evidenced by the assignment recorded at reel 011909, frame 0718.

(2) **RELATED APPEALS AND INTERFERENCES:**

No related appeals or interferences are known.

(3) **STATUS OF THE CLAIMS:**

Pending claims 1-30 are the appealed claims. Claims 1-9, 11-13, 15-18, 20, 22-25 and 27-30 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Billings (U.S. Patent No. 4,714,989) in view of Sugiarto et al. (U.S. Patent Application Publication No. 2002/0002596 A1), and claims 10, 14, 19, 21 and 26 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Billings in view of Sugiarto et al. and further in view of Agraharam et al. (U.S. Patent No. 6,035,339).

(4) **STATUS OF ANY AMENDMENT FILED SUBSEQUENT TO FINAL REJECTION:**

No amendments have been filed subsequent to the July 6, 2005 Final Office Action.

(5) **SUMMARY OF CLAIMED SUBJECT MATTER:**

Example embodiments of the present invention relate to a system and method of storing and associating user information, service information, and network information to improve service creation and negotiation in a wireless network.

Fig. 2 illustrates a wireless network in accordance with an example embodiment of the present invention. All network components are the same as those in the conventional art wireless network shown in Fig. 1, with the exception of a service data node (SDN) 60 and elements associated thereto.

The SDN 60 may include a service creation environment (SCE) 62 and a service database (SDB) 64. The SDN 60 is connected with various network elements, such as, an ATM network 20 and a DA/IWF module 25. The SDN 60 processes and “associates” user and/or service information with network information without having to access various elements located throughout the network, to facilitate service creation and negotiation. As a result, this minimizes network processing and network resources. Here, “associates” may mean the establishing of a relationship between at least two different parameters or the logically linking of at least two different parameters. For example, for a particular user location (user information), the available network resources (network information) for the user at that particular user location is obtained and accessed so that user information and network information are “associated” to have a dependent relationship therebetween. In other words, particular user information is dependent with particular network information such that a logical link exists therebetween.¹

In an example embodiment, the network and service information are stored in the SCE 62, and the user and service information are stored in the SDB 64.² The SCE 62 may be connected with a Web server 66 and accessed by the user via, for example, a mobile station 2. Network information may be stored into the SCE 62 by the service provider via network elements, such as an ATM network 20, a DA/IWF module 25, the Web server 66, etc. The SDB 64, connected to a BSC 10 and to a Home Location Register HLR 70, may store user information, such as, information regarding the wireless network cell location in which the user presently resides in. Service information from the BSC 10 may be stored in the SDB 64 as well. The SCE 62 and the SDB 64 can be updated periodically (e.g., after certain intervals of time) and/or dynamically

¹ Appellants’ specification, para. bridging pages 12 and 13.

² Appellants’ specification, page 13, lines 11-12.

(e.g., updating based on changing network operating environment conditions) to store user, service and network information therein.³

The following describes a method of service creation and negotiation using the SDN 60 according to an example embodiment of the present invention. When a user requests a new service (e.g., getting stock quotes at 12 noon while in New York or Boston), the user places the request via a mobile station 2 which communicates with a base station 5, and a BSC 10 receives the request from the base station 5. The BSC 10 then communicates with the SDN 60, in particular the SDB 64 therein.⁴ However, unlike the conventional art, prior to service creation (or service negotiation) initiated by the user, the SDB 64 has network information dynamically stored therein by various network elements, such as an ATM network 20, a DA/IWF module 25, etc.⁵ Network information is also dynamically stored into the SCE 62 from other network elements, such as a Web server 66 connected to a wireless network 1.⁶

Upon receiving the user request, the SDN 60 proceeds to check its storage to locate the appropriate user information for the particular user making the service request. The SDN 60 also checks its storage to locate the appropriate network information associated with the user and user request, instead of having numerous network elements check their own storage databases as in the conventional art. Additionally, the SDN 60 checks its storage to locate appropriate service information, such as available service resources. In this manner, the user and/or service information and any associated network information may be accessed and compared in the SDN 60.

With the SDN 60 storing network and service information in the SCE 62, and with user and service information stored in the SDB 64, the network processing may be performed through accessing only the SDN 60, to thus quickly ascertain whether the requested service creation or negotiation can be provided. For example, the SDN 60 determines, by comparing the information stored in the SCE 62 and the SDB 64,

³ Appellants' specification, para. bridging pages 14 and 15.

⁴ Appellants' specification, para. bridging pages 17 and 18.

⁵ Appellants' specification, page 18, lines 2-5.

⁶ Appellants' specification, para. bridging pages 18 and 19.

whether there are currently too many users on the network who have requested stock quotes at 12 noon or whether there is a limit on the number of permitted users to receive stock quotes in New York or in Boston. If the requested stock quotes cannot be provided, the user will be quickly informed that the network is at full capacity and asked to attempt access at another time.⁷

If the user wishes to modify (i.e., negotiate) the request, the SDN 60 facilitates the processing involved by accessing its storage having user and/or service information and their associated network information in a manner similar to that described above for service creation.⁸ By associating various user and/or service information with network information, user, service and network information can be stored in a single location such as a database in the SDN 60 or physically distributed databases located throughout the network.⁹ As such, user and/or service information and network information are associated so that each type of information has some relationship with other types of information. Accordingly, different types of information are stored and updated in one or a plurality of physical locations, whereby the different types of information have a logically linked relationship.¹⁰

(6) GROUND OF REJECTION TO BE REVIEWED ON APPEAL:

a) Claims 1-9, 11-13, 15-18, 20, 22-25 and 27-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Billings (U.S. Patent No. 4,714,989) in view of Sugiarto et al. (U.S. Patent Application Publication No. 2002/0002596 A1).

b) Claims 10, 14, 19, 21 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Billings in view of Sugiarto et al. and further in view of Agraharam et al. (U.S. Patent No. 6,035,339).

⁷ Appellants' specification, page 19, lines 10-19.

⁸ Appellants' specification, page 20, lines 6-10.

⁹ Appellants' specification, page 20, lines 10-13.

¹⁰ Appellants' specification, page 20, lines 6-17.

(7) ARGUMENT:

a. **Claims 1-9, 11-13, 15-18, 20, 22-25 and 27-30 are not rendered obvious over Billings in view of Sugiarto**

Appellants respectfully submit that Billings and Sugiarto, individually or in combination, fail to disclose a method of service creation and/or negotiation in a wireless network, comprising, at least:

obtaining, from the storage, user information associated with the request;

obtaining, from the storage, network information associated with the user information;

comparing the request with the user information and the associated network information; and

providing the requested service based on the comparison

as recited in claim 1.

The Examiner alleges that Billings teaches “obtaining from the storage, user information associated with the request, and/or obtaining, from the storage, network information associated with the user information” citing col. 3, lines 9-11 and col. 5, lines 16-19.¹¹ Appellants have reviewed these passages including the entire disclosure of Billings and see no mention or suggestion where obtained user information is associated with the request and/or where obtained network information is associated with the user information. Billings merely discloses that each data center 8 is equipped to respond to requests for service from a user station 4, receive data from the user station 4 and store such data in mass storage, and retrieve data from the mass storage and supply it to the requesting users stations (col. 5, lines 19-24). Accordingly, Billings fails to disclose that the obtained information from the data center is “associated” with particular information, as recited in claim 1..

Further, Billings fails to disclose or suggest comparing the request with the user information and the associated network information, as recited in claim 1. Billings discloses that the data center 8 receives transmitted messages and interrupts the data center communications program 214. The communications program 214 checks the

¹¹ See Office Action, page 2, paragraph 3.

protocol and, if the protocol is in order, the communications program 214 causes transmittal of an acknowledgment signal to the user station 4. If the protocol is not in order, the communications program 214 then causes transmission of signals to the user station 4 to indicate the problem and cause re-transmission of the message.¹²

Accordingly, Billings fails to disclose or suggest "comparing the request with the user information and the associated network information", as recited in claim 1.

With respect to Sugiarto, Appellants submit that Sugiarto also fails to disclose or suggest, at least:

obtaining, from the storage, user information associated with the request;
obtaining, from the storage, network information associated with the user information;
comparing the request with the user information and the associated network information; and (underlining for emphasis)

as recited in claim 1.

Sugiarto merely discloses that when a user attempts to retrieve information from a network, a system server responds to the request by uploading one or more requesting-servicing software modules, identifying the requesting user, and retrieving the user's configuration file from the database server.¹³ This is not the same as both obtaining user information associated with a request, obtaining network information associated with the user information, and comparing the request with the user information and the associated network information.

Accordingly, for at least these reasons, Appellants submit that claim and those claims dependent thereon are allowable over the prior art.

Notwithstanding the above, the rejection is deficient as against the weight of case precedent as directed to obviousness rejections under 35 U.S.C. §103. The claimed invention is directed to a method of service creation and/or negotiation in a wireless network. In fact, there is no real method disclosed in Billings, which shows service creation and/or negotiation in a wireless network. The fact that Billings teaches a data

¹² See col. 7, lines 33-45.

¹³ See Abstract.

processing system does not translate to a specified method, such as a method of service creating and/or negotiating in a wireless network. Yet, the Examiner contends that one would look to the Sugiarto to modify Billings.

Even assuming *arguendo* that Billings teach all that is alleged, which Appellants submit it does not, the skilled artisan would not look to Sugiarto to solve the problems the have been addressed in, and solved by, the present application. In other words, one would not be motivated to combine the teachings of Sugiarto with teachings of Billings. Accordingly, as to be supported below, Appellants submit that the Examiner has (a) failed to make out a *prima facie* case of obviousness to combine Billings and Sugiarto, essentially using Appellants' specification as a blueprint to piece together elements, and (b) has looked to a non-analogous art for a solution to the problem identified in the present application, and not in either Billings or Sugiarto.

Regarding independent claims 4, 7, 12, 17 and 24, Appellants submit that for similar reasons to those stated above with regard to claim 1, that claims 4, 7, 12, 17 and 24 and those claims dependent thereon are also allowable over the prior art.

A. Rejection fails test for establishing prima facie case of obviousness.

Appellants direct the Examiner's attention to two recent cases decided by the Court of Appeals for the Federal Circuit (CAFC), In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999) and In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a prima facie case of obviousness under 35 U.S.C. §103(a). To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. The motivation suggestion or teaching may come explicitly from one of the following:

- (a) the statements in the prior art (patents themselves)
- (b) the knowledge of one of ordinary skill art, or in some cases,
- (c) the nature of the problem to be solved.

See Dembiczak 50 USPQ at 1614 (Fed.Cir. 1999). In Kotzab, the CAFC held that even though various elements of the claimed invention were present (in two separate embodiments of the same prior art reference), there was no motivation to combine the elements from the separate embodiments, based on the teachings in the prior art.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See Dembiczak 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence".

In order to provide motivation for combining Billings and Sugiarto to reject the claims, the Examiner asserts it would have been obvious to:

easily [be] adopted by one of ordinary skill in the art to further modify the method of BILLINGS to operate in wireless network environment to provide the method with wireless communication capability.¹⁴

Appellants submit that one of ordinary skill in art would not think to combine Billings and Sugiarto. The Examiner has not identified any teaching or suggestion, anywhere in Billings or Sugiarto, that would lead one skilled in the art to look to Sugiarto in order to figure out a way to create and/or negotiate a service in a wireless network. Accordingly, Appellants respectfully submit that claim 1 is allowable for at least the additional reason that the Examiner has failed to establish a proper *prima facie* case of obviousness under 35 U.S.C. 103(a), in view of Dembiczak and Kotzab.

B. Examiner using Impermissible Hindsight.

The Examiner is using impermissible hindsight reconstruction to reject the claims. The Examiner has used the present application as a blueprint, selected a prior art method of distributing data processing system as the main structural device, and then searched other prior art for the missing elements without identifying or discussing any specific evidence of motivation to combine, other than providing conclusory statements regarding the knowledge in the art, motivation and obviousness. The

¹⁴ See Office Action, page 4, paragraph 2.

Federal Circuit has noted that the PTO and the courts "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention," In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988), and that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. Dembiczak, 50 USPQ2d at 1617. Appellants respectfully submit that claim 1 is allowable for at least this additional reason.

C. Examiner has not provided requisite motivation to combine references.

The Examiner has not provided the requisite evidence to support his allegation that there is motivation to combine Billings and Sugiarto so as to render obvious that which Appellants have described. The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

The Examiner has not provided the requisite showing of a suggestion, teaching, or motivation to combine the prior art references to reject claim 1 in the present application. "The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d

1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 50 USPQ2d at 1617 ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The Examiner must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Accordingly, the Examiner has not adequately supported the selection and combination of Billings and Sugiarto to render obvious that which Appellants have described. The Examiner's conclusory statement because it would be "easily adopted by one of ordinary skill in the art to further modify the method of Billings to operate in wireless network environment to provide the method wireless communication capability" does not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553,

220 USPQ 303, 312-13 (Fed. Cir. 1983). The Examiner must explain the reasoning behind his findings of motivation. Simply stating that the motivation for combining Billings and Sugiarto is because it is easily adoptable is an insufficient explanation for the alleged combination.

Further, the Examiner is reminded that deferential judicial review under the Administrative Procedure Act does not relieve the agency (in this case the USPTO) of its obligation to develop an evidentiary basis for its findings. To the contrary, the Administrative Procedure Act reinforces this obligation. See, e.g., Motor Vehicle Manufacturers Ass'n v. State Farm Mutual Automobile Ins. Co., 463 U.S. 29, 43 (1983) ("the agency must examine the relevant data and articulate a satisfactory explanation for its action including a 'rational connection between the facts found and the choice made.'") (quoting Burlington Truck Lines v. United States, 371 U.S. 156, 168 (1962)). In this respect, since the examiner has not provided the requisite suggestion in the references to make his alleged combination, the Examiner rejects the precedent in In re Sung Lee, 23 USPQ2d 1780 (Fed. Cir. 2002).

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action. See Motor Vehicle Manufacturers, 463 U.S. at 43 ("an agency rule would be arbitrary and capricious if the agency . . . entirely failed to consider an important aspect of the problem"); Mullins v. Department of Energy, 50 F.3d 990, 992 (Fed. Cir. 1995) ("It is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action."). As discussed in National Labor Relations Bd. v. Ashkenazy Property Mgt. Corp., 817 F.2d 74, 75 (9th Cir. 1987), an agency is "not free to refuse to follow circuit precedent." Appellants submit that the Examiner has failed to provide a specific hint or suggestion in any of Billings and Sugiarto to support the alleged combination. In light of the weight of the above precedent, and in addition to the reasons in A) and B) above,

Appellants respectfully submit that claim 1 is allowable.

Claims 2-4 which depend upon claim 1, are also patentable for the reasons stated above with respect to claim 1, as well as on their own merits.

Withdrawal and allowance of the application are respectfully requested.

b. Claims 10, 14, 19, 21 and 26 are not rendered obvious over Billings in view of Sugiarto and further in view of Agraharam

Appellants submit that Billings and Sugiarto, individually or in combination, fail to suggest the claimed invention as found in claims 7, 12, 17 and 24, the independent claims from which the rejected claims depend. Appellants submit that Agraharam fails to cure the deficiencies described above regarding Billings and Sugiarto namely, that Agraharam fails to teach or suggest either of the obtaining functions and/or the comparing function as recited in claim 1. Accordingly, as the combination fails to teach or disclose each and every feature of the claims, the rejection under 35 U.S.C. 103 is improper.

Accordingly, claims 10, 14, 19, 21 and 26 are separately patentable for at least the reasons set forth above. Withdrawal of the rejection is respectfully requested.

(8) CONCLUSION

For all the reasons set forth above, the present invention as recited in Appellants' pending claims 1-30 are not rendered obvious to one skilled in the art as asserted by the Examiner. Accordingly, it is respectfully submitted that the claimed invention should properly be patentable over the cited art. It is therefore respectfully requested that this Appeal be granted by the panel and that the Examiner be reversed.

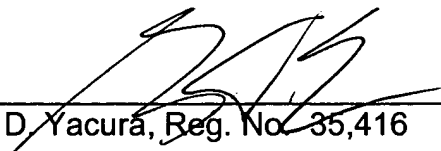
In the event that any matters remain at issue in the application, the Examiner is invited to contact the undersigned at (703) 668-8000 in the Northern Virginia area, for the purpose of a telephonic interview.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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Attached: (9) Appendix: Pending claims of record

(9) CLAIMS APPENDIX:

1. A method of service creation and/or negotiation in a wireless network, comprising:

receiving a request for service creation or negotiation;
accessing a logically linked dynamic storage in accordance with the request;
obtaining, from the storage, user information associated with the request;
obtaining, from the storage, network information associated with the user
information;

comparing the request with the user information and the associated network
information; and

providing the requested service based on the comparison.

2. The method of claim 1, wherein the logically linked dynamic storage is
dynamically updated in accordance with the user and network information.

3. The method of claim 1, wherein the step of providing the requested
service is

performed by accessing the logically linked dynamic storage without having to
access any other portions of the network to minimize signal overloading.

4. A method of service creation and/or negotiation in a wireless network,
comprising:

receiving a request for service creation or negotiation;

accessing a logically linked dynamic storage in accordance with the request;
obtaining, from the storage, service information associated with the request;
obtaining, from the storage, user information associated with the service
information;
obtaining, from the storage, network information associated with the user
information;
comparing the service information and user information with the associated
network information; and
providing the requested service based on the comparison.

5. The method of claim 4, wherein the logically linked dynamic storage is
dynamically updated in accordance with the user, service and network information.

6. The method of claim 4, wherein the step of providing the requested
service is performed by accessing the logically linked dynamic storage without having to
access any other portions of the network.

7. A method of service creation and negotiation in a wireless network,
comprising:
receiving a request from a user to create or negotiate a service;
accessing a storage having user information, service information and network
information stored therein;

comparing the request with the user information, the service information and the network information; and

providing the data service to the user based upon the comparison.

8. The method of claim 7, further comprising:
periodically obtaining user, service and network information; and
dynamically updating the storage by periodically storing the periodically obtained user, service and network information.

9. The method of claim 8, wherein the dynamic storing includes storing network information into at least a first database.

10. The method of claim 9, wherein the dynamic storing includes storing user information into a second database.

11. The method of claim 7, wherein the accessing step is performed without having to access any other portions of the wireless network.

12. A method of user configurable service creation and negotiation in a wireless network, comprising:

receiving a request from a user to create or negotiate data services;

accessing at least a first database having network information and user information stored therein;

comparing the requests with the network information and the user information;
and

providing the data services to the user based upon the comparison.

13. The method of claim 12, further comprising a step of dynamically storing the network information and the user information into the first database, the network information being wireless network information.

14. The method of claim 13, further comprising a step of dynamically storing Web-based network information into a second database.

15. The method of claim 12, wherein the accessing step is performed without having to access any other portions of the wireless network.

16. The method of claim 12, further comprising the step of periodically updating at least the first database with updated network and user information.

17. A system allowing service creation and negotiation in a wireless network, comprising:

a receiver to receive a request from a user to create or negotiate a service; and

a central processing node to process the request by comparing the request with user information, service information and network information dynamically stored therein, and to provide the requested service to the user based upon the comparison.

18. The system of claim 17, wherein the central processing node further comprises a first database having the network information dynamically stored therein.

19. The system of claim 18, wherein the central processing node further comprises a second database having the user information dynamically stored therein.

20. The system of claim 17, further comprising a first database having the network information dynamically stored therein.

21. The system of claim 20, further comprising a second database having the user information dynamically stored therein.

22. The system of claim 17, wherein the central processing node compares the network information and the user information without having to access any other portions of the wireless network.

23. The system of claim 17, wherein the central processing node periodically updates the network information and the user information.

24. A system allowing service creation and negotiation in a wireless network, comprising:
at least a first database storing network information and user information; and
a central processing node processing user requests by accessing the first database, comparing the requests with the network information and the user information dynamically stored in the first database, and providing the requested services to the users based upon the comparisons.

25. The system of claim 24, wherein the first database has the network information and the user information dynamically stored therein, the network information being wireless network information.

26. The system of claim 25, further comprising:
a second database having Web-based network information dynamically stored therein; and wherein the central processing node compares the requests with the network information and the user information stored in the first and second databases.

27. The system of claim 24, wherein the central processing node accesses the first database without having to access any other portions of the wireless network.

28. The system of claim 24, wherein the central processing node periodically updates at least the first database with updated network and user information.

29. The system of claim 24, wherein the first database has a plurality of portions being physically distributed throughout the entire wireless network, the distributed portions being connectively linked with the central processing node.

30. The system of claim 24, wherein the central processing node includes the first database.